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In re Application of ROBERTSON et al
U.S. Application No.: 10/532,098
PCT Application No.: PCT/US03/14533
Int. Filing Date: 16 May 2003
Priority Date Claimed: 21 October 2002
Attorney Docket No.: C2ABU043.C29
For: COMPOUND OPTICAL AND ELECTRICAL
CONDUCTORS, AND CONNECTORS
THEREFOR

DECISION

This is in response to applicant's "Petition to Proceed Without Inventor's Signature Under 37 CFR 1.47" filed 14 March 2006.

BACKGROUND

On 16 May 2003, applicant filed international application PCT/US03/14533, which claimed priority of an earlier United States application filed 21 October 2002. The thirty-month period for paying the basic national fee in the United States expired on 21 April 2005.

On 21 April 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 13 September 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 14 March 2006, applicant filed the present petition under 37 CFR 1.47(a), which is also being treated as a request for status under 37 CFR 1.42.

DISCUSSION

I. Request for Status Under 37 CFR 1.42

The declaration filed with the present petition states that joint inventor Robert Currie is deceased.

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

The declaration either fails to state the citizenship of the deceased inventor or fails to state the citizenship of the legal representative. The single indication of "US" as the country of citizenship cannot be applied to both the deceased inventor and the legal representative.

II. Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventor on his own behalf and on behalf of the nonsigning legal representative of the deceased inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

* * *

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition fails to specify whether the legal representative Problems Currie cannot be found or refuses to sign. The letter to Currie dated 07 March 2006 does not specify a deadline for reply and does not indicate that a failure to respond would be treated as a refusal to sign. Furthermore, the letter states that the recipient may respond by faxing back the signature page. Applicant is advised that a composite declaration consisting of two original sheets and a faxed signature page will not be acceptable. It is improper to combine pages of different documents into a single declaration, since the pages were not together at the time of execution.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition fails to state the last known address of the nonsigning legal representative.

CONCLUSION

For the reasons in §I above, the request for status under 37 CFR 1.42 is DISMISSED without prejudice.

For the reasons in §II above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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